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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,950	12/17/2001	Mark J. Stefik	111325-87	3970

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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,950

Applicant(s)

STEFIK ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-69 (Amended numbers) have been examined.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,638,443 to Mark J. Stefik.

3. As for claim 1 of U.S. Patent No. 5,638,443 recites:

- Creating instances of composite digital work
- Creating description structures and blocks (usage right)
- Storing description structures and blocks (usage rights)
- A repository having means for processing usage transaction request (receiving request, comparing the request with stored procedures, and granting usage rights)
- Means to determine if access to digital work can be granted

4. Claim 1 of U.S. Patent No. 5,638,443 differs since it further recites additional claim limitations.

These limitations include a repository receiving a request and associated processing system. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No.

5,638,443 by removing certain elements resulting in a claim such as claims 1 of current application, since

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both claims actually perform the same function. It is well established that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). It is the same for just mere rearrangement of claims as it is obvious that the merits of claims does not change by groupings or dependency.

5. As for claims 2-9, the same rational as above exists. Even though the language of the claims are slightly different the essence of invention claimed in the claims are the same and they deemed to be the same as claims 1-6. Just rearrangements and removing further limitations from a claim does not make claims patentable.

6. The MPEP Further Notes:

The court in *Vogel* recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103 since only the disclosure of the invention claimed in the patent may be examined."

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 18-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims as presently claimed and best understood were considered in light of the new "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

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The specification has been reviewed to see if the disclosed invention is in the technological art and that it has a practical use in the art. The review shows that the system uses a computerized method or system to achieve the creation of the rights to the digital works in addition to creating the rights attachment itself which are merely data stored in a data base along with sequence of header tags.

It is noted that method claims 18-23 fail to recite/define a computer, machine or device that would render the claims in the technological arts and in statutory status.

Furthermore, as for claim 18, the invention, as defined by the claim and as best understood by the examiner merely manipulate an abstract idea or perform a purely mathematical algorithm without any limitation to a practical application in the technological arts. However, the claimed invention manipulates data representing description blocks (attributes and conditions), which are abstract and non-limiting. The invention does not require physical acts to be performed outside the computer independent of and following the steps to be performed by the programmed computer, where those acts involve the manipulation of tangible physical objects and results in the object having a different physical attribute or structure. See *Diamond v. Diehr*, 450 US at 187, 209 USPQ at 8. The steps of computer processing data related to usage rights (attributes and conditions) do not impose independent limitations on the scope of the claims beyond those required by the mathematical operation and abstract limitations because the attributes represented by symbols and conditions, which are purely abstract are not actually measured values of physical phenomena. *In re Galnovatch*, 595 F. 2nd at 41 n.7, 201 USPQ at 145 n.7; *In re Sarker*, 588 F.2nd at 1331, 200 USPQ at 135. The steps of "digital content" and "a description structure" have no direct effect on the physical world outside the computer. Thus, the claimed invention merely associates certain data with certain other data "a plurality of description blocks" (attributes and conditions) and performs a mathematical algorithm without any limitation to a practical application as a result of the algorithm or outcome and is therefore deemed to be non-statutory.

Claims 19-23 are rejected as being dependent claims to above mentioned claims that have been rejected under 35 U.S.C. 101. Same rejection rational is applied for rejecting these claims.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S Patent No. 5,260,999 Robert M. Wyman.

As for claims 1, 12, and 18, Wyman discloses a method for creating a composite digital work having usage rights, said method comprising:

a) creating a digital content portion of a composite digital work including a plurality of content parts (See Wyman figures 1-46 and associated text, column 6, lines 49-65 and column 7, lines 3-35); and

b) creating a description structure for said composite digital work, said description structure comprising (See Wyman figures 1-46 and associated text, column 11, lines 3-30 and column 12, lines 16-60);

a plurality of description blocks containing usage rights associated with at least a corresponding at least one of said content parts,

said usage rights specifying a manner of use for the corresponding one of said content parts,

said manner of use indicating one or more stated purposes for which the corresponding digital content portion can be at least one of used and distributed by an authorized user (See Wyman figures 1-46 and associated text, column 6, lines 49-67, column 7, lines 3-28, column 10, lines 14-68, column 11, lines 1-30, column 12, lines 1-40, column 12, lines 1-60, and column 38, lines 41-55).

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As for claims 2 and 19, Wyman discloses a method as recited in claims 1 and 18, wherein said step (a) comprises the steps of:

a1) creating a first content part of said composite digital work;

a2) creating a second content part of said composite digital work; and

a3) combining said first content part and said second content part to form said content portion

(See Wyman figures 2, 3, 4, 10, and 16 and associated text and column 31, lines 37-68 and column 32, lines 1-67).

As for claims 3, 13, and 20, Wyman discloses a method as recited in claims 2, 12, and 18, wherein said step (b) comprises:

b1) creating a first description block associated with said first content part;

b2) creating a second description block associated with said second content part; and

b3) creating a third description block associated with the combination of said first content part and said second content part (See Wyman figures 2, 3, 4, 10, and 16 and associated text and column 31, lines 37-68 and column 32, lines 1-67).

As for claims 4 and 21, Wyman discloses a method as recited in claims 3 and 20, wherein said steps (a2) and (b2) comprise obtaining an existing digital work having a description block associated therewith as said second content part and said second description block (See Wyman figures 2, 3, 4, 10, and 16 and associated text and column 31, lines 37-68 and column 32, lines 1-67).

As for claims 5, 14, and 22, Wyman discloses a method as recited in claims 3, 13, and 20, wherein said step (b) comprises linking said first description block, said second description block and said third description block in a manner corresponding to the organization of said composite digital work (See Wyman figures 2, 3, 4, 10, and 16 and associated text and column 31, lines 37-68 and column 32, lines 1-67).

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As for claim 6, Wyman discloses a method as recited in claim 3, further comprising the step of storing said composite digital work in a repository (See Wyman figures 1, 2, 3, 4, and 7 and associated texts and column 6, lines 49-67, column 8, lines 54-57, column 10, lines 58-68, and column 11, lines 1-16).

As for claim 7, Wyman discloses a method as recited in claim 6, further storing step comprises; the steps of storing said description structure in a first storage means and storing said digital content portion in a second storage means (See Wyman figures 1, 2, 3, 4, and 7 and associated texts and column 6, lines 49-67, column 8, lines 54-57, column 10, lines 58-68, and column 11, lines 1-16).

As for claims 8, 15, and 23, Wyman discloses a method as recited in claims 7, 14, and 20, wherein each of said first description block, said second description block and said third description block comprise;

a pointer to a corresponding content part stored in said second storage means and a control information part storing usage rights for said corresponding part of said content portion and wherein said step of creating a first description block comprises specifying a first set of usage rights and storing the first set of usage rights in said control information part of said first description block (See Wyman figures 1, 2, 3, 4, 7, 10, and 16 and associated text and column 6, lines 49-67, column 8, lines 54-57, column 10, lines 58-68, column 11, lines 1-16, column 31, lines 37-68 and column 32, lines 1-67).

As for claims 9 and 16, Wyman discloses a method as recited in claims 8 and 14, wherein said step of creating a third description block comprises specifying a second set of usage rights and storing the second set of usage rights in said control information part of said third description block (See Wyman figures 1, 2, 3, 4, 7, 10, and 16 and associated text and column 6, lines 49-67, column 8, lines 54-57, column 10, lines 58-68, column 11, lines 1-16, column 31, lines 37-68 and column 32, lines 1-67).

As for claim 10, Wyman discloses a method as recited in claim 3, wherein said step of creating said second content part comprises extracting said second content part from an existing digital work (See

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Wyman figures 1, 2, 3, 4, 7, 10, and 16 and associated text and column 6, lines 49-67, column 8, lines 54-57, column 10, lines 58-68, column 11, lines 1-16, column 13, lines 9-68, column 14, lines 1-67, column 17, lines 49-57, column 28, lines 37-56, column 31, lines 37-68 and column 32, lines 1-67).

Claims 11 and 17, the method as recited in claims 8 and 14, wherein said step of creating a third description block comprises specifying a second set of usage rights and storing the second set of usage rights in said control information part of said third description block, said second set of usage rights including a usage right indicating that no subsequent description blocks for specifying usage rights may be added to the description structure (See Wyman figures 1, 2, 3, 4, 7, 10, and 16 and associated text and column 6, lines 49-67, column 8, lines 54-57, column 10, lines 58-68, column 11, lines 1-16, column 13, lines 9-68, column 14, lines 1-67, column 17, lines 49-57, column 28, lines 37-56, column 31, lines 37-68 and column 32, lines 1-67).

Conclusion

10. The applicant has submitted over 178 references consisting of over 3000 pages of document. In order for the examiner to properly determine patentability over prior art submitted, it is kindly requested that the applicant explain the significance of each reference or highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. It is desirable to avoid the submission of long list of documents. Examiner request elimination of clearly irrelevant and marginally pertinent cumulative information. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.* 359 F. Supp. 948, 175 USPQ 260 (S.D.Fla.1972), aff'd, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), cert. Denied, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patent No. 5,023,907 to Herrick J. Johnson, Network License Server. Patent No. 5,381,526 to Richard N. Ellson, Method and Apparatus for Storing and Retrieving Generalized Image.

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Patent No. 6,404,898 to Geoffrey G. Rhoads, Method and System for Recording Image and Audio Content.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

Crystal Park 5, 2451 Crystal Drive

7th floor receptionist, Arlington, VA, 22202

Abdi/K

October 15, 2002


JAMES P. TRAMMELL
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